



REMARKS/ARGUMENTS

1. In the above referenced Office Action, the Examiner reasserted that statement that the response filed on 10/2/03 was not fully responsive for failing to elect a species to be examined and that the response of 3/3/04 was not a bona fide response. The applicant respectfully contends that the second restriction regarding the species is inappropriate and should be withdrawn.
2. In an Office Action dated August 13, 2002 regarding the above referenced patent application, a Restriction Requirement was imposed against the following claim groups:
 - I. Claims 1-15, drawn to an on-chip inductor, classified in class 257, subclass 531; and
 - II. Claims 16-30, drawn to a method for manufacturing an on-chip inductor, classified in class 438, subclass 15+.

In an appropriate response to the Office Action filed on 10/2/03, the Applicants provisionally elect Group I with traverse.

3. In an Office Action mailed on 12/31/03, the Examiner stated that the response filed on 10/2/03 was not fully responsive for failing to elect a species to be examined. The Examiner further stated that the method claims have already been withdrawn from consideration, however, a second restriction requirement was sent in regard to the several species that are being claimed.

4. In the office action mailed on 6/27/03 ("the second restriction requirement"), the Examiner stated that this application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1A - 1B;

Species II: Figures 2A - 2B;

Species III: Figures 3A - 3B;

Species IV: Figures 4A - 4B;

Species V: Figure 5;

Species VI: Figures 6A - 6B;

Species VII: Figures 7A - 7B; and

Species VIII: Figures 8A - 8B.

5. In a response to the 12/31/03 Office Action mailed on 3/3/04, the applicant argued, among other things, that, based on the groupings provided by the Examiner, an election could not be made since the groupings are based on the figures and not on the claims.

6. In an Office Action mailed 4/9/04, the Examiner deemed the applicant's response as being non-responsive and provided a listing of species relating to the claims. The list is as follows:

Species I: Figures 1A - 1B, which correspond to claims 1 and 6;

Species II: Figures 2A - 2B, which correspond to claim 2;

Species III: Figures 3A - 3B, which correspond to claims 1, 2, 6, 9 and 10;

Species IV: Figures 4A - 4B, which correspond to claims 1 - 3, 5, 6, 9, and 10;

Species V: Figure 5, which correspond to claims 1, 2, 4, 6, 7, 9, 10, and 11;

Species VI: Figures 6A - 6B, which correspond to claims 1, 2, 6, 8, 9, 10, and 12;

Species VII: Figures 7A - 7B, which correspond to claims 1, 2, 4, 6, 7, 9, 10, and 11; and

Species VIII: Figures 8A - 8B, which correspond to claim 13;

The Examiner further stated that claims 14 and 15 appear not to read on any of the Species.

The applicant disagrees with the Species grouping of the Examiner and with the statement that claims 14 and 15 appear not to read on any of the Species.

7. 37 CFR § 1.141(a) states, in part, that "more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims..." [emphasis added]

8. MPEP § 806.04(e) states, in part, "Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments with the breadth and scope of definition (and thus be designated a generic or genus claim)." [emphasis added]

9. Given the above listing of Species, as provided by the Examiner, and the above Sections of 37 CFR and the MPEP, it is clear that the Species grouping by the Examiner is incorrect. As such, the requirement for election of a particular species should be withdrawn and claims 1 - 15 of the patent application should be examined.

In particular, the cited portion of the 37 CFR 1.141(a) states that different species of an invention occur in different claims. In the present instance, the Examiner indicated that numerous claims cover numerous species. For example, claim 1 is included in Species I, III, IV, V, VI, and VII. Further, the cited portion of MPEP § 806.04(e) defines a generic claim as "a claim may include two or more of the disclosed embodiments with the breadth and scope of definition".

As such, the grouping of the claims as indicated by the Examiner illustrates that many of the claims are generic claims and not species claims. As such, the patent application includes generic claims, thus rendering the requirement to elect a single species moot.

For the foregoing reasons, the applicant believes that the requirement for further election of a species claim be withdrawn.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

RESPECTFULLY SUBMITTED,

By:



Timothy W. Markison
Registration No. 33,534
Phone: (512) 342-0612
Fax No. (512) 342-1674

CERTIFICATE OF MAILING

37 C.F.R 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Alexandria, Virginia 22313, on the date below:

Date

6/28/04

Signature

